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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,716	01/11/2001	Ronald Alan Coffee	BER-3.5.009/3714	1036

7590 10/07/2004

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EXAMINER

LEWIS, KIM M

ART UNIT PAPER NUMBER

3743

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/758,716

Applicant(s)

COFFEE, RONALD ALAN

Examiner

Kim M. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2004 and 12 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-103 is/are pending in the application.
- 4a) Of the above claim(s) 42-46, 50-58, 60, 62-64 and 81-103 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 47-49, 59, 65 and 66 is/are allowed.
- 6) ☒ Claim(s) 61, 67, 68, 76 and 79 is/are rejected.
- 7) ☒ Claim(s) 69-75, 77, 78 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/8/03 and 3/3/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Summary

1. The office action is in response to the election received 5/19/04 and the response to the non-compliant amendment received 7/12/04.
2. Claims 1-41 have been cancelled and Claims 68-103 have been added. Claims 42-103 are currently pending in the instant application.

Election/Restrictions

3. Applicant's election with traverse of Group V, claims 47-49,59,61 and 65-67 in the reply filed on 5/19/04 is acknowledged. The traversal is on the ground(s) that the examiner has grouped the claims into twelve distinct inventions, yet the distinct inventions have been divided into only seven different classes. Consequently, applicant contends that since several claims share common classes as well as overlapping subject matter, the examiner would not be placed under undue burden by combining these claims because they share common classes and would necessarily be searched by the examiner at the same time. This is not found persuasive because even though the distinct inventions may share a common class, they have been classified into distinct subclasses. Additionally, the applicant must note that the examiner not only searches the class and subclass in which the subject matter is classified, but also any other related classes and/or subclasses. These additional classes and/or subclasses that must be searched place an undue burden on the examiner.

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As to the newly submitted claims, the examiner contends that a portion of the claims read on the elected group, namely claims 68-80. However, claims 81-103 are directed to different inventions and if presented, they too would have been placed in independent and distinct groupings.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

4. The information disclosure statement filed 9/8/03 and 3/3/04 have been received and made of record. Note the acknowledged PTO-1449 forms enclosed herewith.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "8" as shown in Fig. 4 and "j" and "c" as shown in Figs. 8 and 13. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of

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any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Suggestions

6. Claims 47, 48 and 75 are objected to because of the following informalities:

Claim 47, line 8, "deposit" should read --deposited--; and

Claim 47, line 9, "the deposited web or mat" lacks antecedent basis, applicant is encouraged to provide antecedent basis for the claimed terminology.

Claim 48, line 4 "last" should read --least--; and

Claim 48, line 7, "deposit" should read --deposited-- .

Claim 75, lines 1, "the bandage" lacks antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 61, 68 and 76 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,043,331 ("Martin et al.").

As regards claim 61 and 68, Martin et al. disclose a method of forming at least partially solid material by subjecting a liquid at an outlet (col. 6, line 56) to an electric field causing the liquid to form at least one jet of electrically charged liquid, the liquid being such that after formation, the jet forms a fiber (col. 1, lines 13-23).

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As to applicant's recitation "to provide nuclei or otherwise initiate interactive cellular and/or molecular events in tissue repair", the applicant is directed to col. 2, lines 12-17, which recites "[w]here the dressing is formed from a wettable polymer, blood or serum escaping from the wound tends to penetrate the dressing and the high surface area encourages clotting. Such dressing may be used as emergency dressings to halt bleeding." This disclosure clearly meets the limitation of initiating interactive molecular events in tissue repair.

As regards claim 76, Martin et al. disclose that the formed fibers are collected to form a mat having a plurality of layers.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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11. Claims 67 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al.

As regards claim 67, Martin et al. disclose a method of forming at least partially solid material by subjecting a liquid at an outlet (col. 6, line 56) to an electric field causing the liquid to form at least one jet of electrically charged liquid, the liquid being such that after formation, the jet forms a fiber (col. 1, lines 13-23).

Martin et al. fail to teach that the charged liquid partially solidifies to form "electrically charged gel-like matter" and that the flow of liquid to the liquid outlet is regulated. However, the examiner contends that the charged liquid is capable of forming gel-like matter (col. 1, lines 13-21 and col. 4, line 64- col. 5, line 9) and that one having ordinary skill in the art would have been motivated to regulate the flow of liquid to the liquid outlet in order to determine the particle size (thinness).

As regards claim 79, Martin et al. disclose at col. 1, lines 34-37 that "[i]t is also possible to post-treat such mats with other materials **to modify their properties, for example to increase their strength or water resistance.**

As such it would have been obvious to one having ordinary skill in the art to modify the mat with an other material such as a surfactant in order to increase strength or water resistance.

Allowable Subject Matter

12. Claims 47-49, 59, 65 and 66 are allowed.


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13. Claims 69-75, 77, 78 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is 703.308.1191. The examiner can normally be reached on Mondays to Thursdays from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703.308.0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kim M. Lewis
Primary Examiner
Art Unit 3743

kml
October 4, 2004